

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action mailed March 28, 2005. At the time of the Final Office Action, Claims 1-3, 5-15, 17-21, 23-28, and 30 were pending in the Application. Applicant amends Claims 1, 14, 20, and 28 and cancels Claims 5, 17, 25, and 30 without prejudice or disclaimer. The amendments and cancellations to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1-6, 10-11, 14-25, and 28-30 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,052,718 issued to Gifford (hereinafter "*Gifford*"). This rejection is respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup> In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."<sup>2</sup> In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."<sup>3</sup> Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.<sup>4</sup>

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<sup>1</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. §2131.

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); M.P.E.P. §2131 (*emphasis added*).

<sup>3</sup> M.P.E.P. §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

<sup>4</sup> M.P.E.P. §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

Using the preceding well-settled jurisprudence, it is clear that *Gifford* fails to anticipate Independent Claim 1. For example, Independent Claim 1, as amended, recites a method for providing a distributed service in a network that includes: “receiving lease constraints associated with a request to use the distributed service, wherein the lease constraints include a percentage of the distributed service available and *an amount of resources required to execute the percentage of the distributed service*...wherein the lease constraints comprise a required portion of the distributed service requested for use, and wherein the determining to move the distributed service comprises: measuring an available portion of the distributed service on the first virtual machine; and moving the distributed service to the second virtual machine on the second router if the required portion is greater than the available portion.”

At the portion cited by the Examiner for these elements, *Gifford* discloses: “If there are matching entries in the replica summary records in the routing database then at step 570 each matching replica summary record entry has its advertised network performance added to the network performance estimated from the client to the network router it matched. One way to estimate this performance is to take the round-trip performance observed from the replica router to the client and adjust for the round-trip performance from the replica router to the network router that matched. The N matching replica advertisement entries that contain the best aggregate network performance metric values are selected, and the IP addresses contained in these replica advertisement entries are made the candidate target IP addresses. Each entry in the candidate target IP address list includes a descriptor indicating if it is a replica router or server replica; this information is determined from the entry's replica advertisement. The N IP addresses are ordered by decreasing network metric merit. Control then transfers to step 590. At step 590 a new URL is computed that consists of the URL sent in message 515 with its network address portion replaced by the IP address that is the highest on the candidate target IP address list. The new URL is sent back to the client in redirect message 595.

At step 596 the client processes the redirect. If the new URL points to a replica router, then the client will automatically start again at step 510 using a different replica router. One application of such a redirect is to redirect a client to a replica router that is behind a firewall that is specialized for server replicas in the client's intranet. If the new URL

points to a server replica, then the server replica will return pages that contain relative links for all requests that can be serviced from the replica, and absolute links to a master server for all requests that need to be serviced by a master server. Relative links allow the client to carry the local server replica host name from request to request, as well as optional information such as a session identifier or digital receipt. Absolute links created by a server replica can encode similar information including session identifiers, and also always encode the IP address of the referring server replica, so that the master server can learn the IP address of the referring replica to enable the master server to redirect the client back to the referring replica once the master server has finished its specialized processing.” (See *Gifford*, columns 8-9: lines 30-5.)

After thoroughly evaluating this passage it becomes evident that *Gifford* fails to offer a number of the elements cited in Independent Claim 1. For example, *Gifford* does not provide any disclosure about an amount of resources required to execute the percentage of the distributed service. The Examiner should be aware that there are two components of “lease constraints” of Independent Claim 1: 1) the percentage of the distributed service available; and 2) the amount of resources required to execute the percentage of the distributed service. Note that this is not an either-or-proposition for the Examiner in the context of anticipation. The Examiner must point to both of these elements in *Gifford* in order to properly support his §102 rejection.

In contrast to the subject matter of the pending claims, *Gifford* only accounts for a generic performance metric and, further, appears to simply evaluate connection information or round-trip time data in making its routing decision. *Gifford* does not identify the actual resources required to execute the distributed service. This is because the architecture of *Gifford* operates in a different manner, as its chief endeavor relates to HTTP-direction. Hence, *Gifford* does not disclose this limitation because it does not need to in making simple HTTP-directional routing decisions. The claimed subject matter has applications to voice, video, etc. and, thus, takes this resource information into account before opting to pass the distributed service to another machine.

Referring back to Independent Claim 1, a simple request for a distributed service would be received by the first machine. The request could be for video data applications, for example, and the amount of resources could be significant for the first virtual machine. The

first virtual machine is therefore being provided with this important information before it makes a routing decision. It also receives a percentage of the distributed service available. It does not generically solicit bandwidth information without having known the resources associated with the request. This is pertinent to the operations of the pending subject matter, as detailed below.

Being armed with both data segments, then the machine can determine to move the distributed service, which comprises “measuring an available portion of the distributed service on the first virtual machine; and moving the distributed service to the second virtual machine on the second router if the required portion is greater than the available portion.” Hence, once the percentage available data and the resources required parameter have been ascertained, then the first virtual machine can decide, “Hey, I can handle this one -OR- No, I need to forward this to the second virtual machine to handle.” There is nothing relevant in *Gifford* that would anticipate these operations or capabilities. Accordingly, Independent Claim 1 is patentable over *Gifford* for at least these reasons.

Thus, because the teachings of *Gifford* fail to offer such operations and disclosure (or provide anything that is even relevant for such teachings), Independent Claim 1 is clearly patentable over *Gifford*. Additionally, Independent Claims 10, 14, 20, and 28 include a similar limitation and, thus, are also allowable over *Gifford* for similar reasons. In addition, the corresponding dependent claims associated with these Independent Claims are also patentable over *Gifford* for analogous reasons.

### Section 103 Rejections

The Examiner rejects Claims 7-9, 12-13, and 26-27 under 35 U.S.C. §103(a) as being unpatentable over *Gifford* in view of U.S. Patent No. 5,341,477 issued to Pitkin et al. (hereinafter “*Pitkin*”). This rejection is respectfully traversed for the following reasons.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.<sup>5</sup>

It is respectfully submitted that these rejected Claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation. This has been evaluated thoroughly in the §102 analysis provided above. Furthermore, these secondary references do not provide any disclosure that is combinable with *Gifford* that could inhibit the patentability of the pending claims.

Applicant also wishes to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, the proposed *Gifford-Pitkin* combination is still improper because the Examiner has not shown the required suggestion or motivation in *Gifford* or in *Pitkin*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>6</sup> Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified does not make the modification obvious unless the prior art suggests the desirability of the modification.<sup>7</sup> Nothing in *Gifford* or in *Pitkin* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.<sup>8</sup> Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient

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<sup>5</sup> See M.P.E.P. §2142-43.

<sup>6</sup> M.P.E.P. §2143.01 (emphasis in original).

<sup>7</sup> In *re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

<sup>8</sup> If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

M.P.E.P.<sup>9</sup> guidelines and governing Federal Circuit case law.<sup>10</sup> The M.P.E.P. consistently confirms that this approach is improper and, thus, it should not be used here.<sup>11</sup>

In the context of the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a *prima facie* case of obviousness. Accordingly, these rejected claims are also allowable over the references cited by the Examiner based on, at least, this reason.

Therefore, all of the pending claims have been shown to be allowable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of the pending claims.

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<sup>9</sup> See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

<sup>10</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

<sup>11</sup> See M.P.E.P. §2145.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$790.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,  
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